REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed February 8, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(b)

A. Statement of the Rejection

Claims 1-14, 18-22, 24-37, and 41-45 have been rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by *Browne et al.* ("*Browne*," WO 92/22983). Applicants respectfully traverse this rejection.

B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the *Browne* reference. Applicants discuss the *Browne* reference and Applicants' claims in the following.

Independent Claim 1

Claim 1 recites (with emphasis added):

> 1. A system for managing the allocation and storage of media content instance files in a hard disk of a storage device coupled to a media client device in a subscriber television system, comprising:
>
> a memory for storing logic;
>
> a buffer space in the hard disk for buffering media content instances as buffered media content instance files; and
>
> ***a processor configured with the logic to track the size of permanent media content instance files and the buffered media content instance files to provide an indication of available free space, such that the indication is independent of the buffer space.***

Applicants respectfully submit that *Browne* does not disclose at least the above emphasized claim features. With regard to the emphasized features, the Office Action provides the following explanation:

> Page 24 last two lines and page 25 first two lines and Figure 6 upper right hand corner teach an indication of free space in storage section 104 and Page 7 last paragraph teaches a FIFO buffer element 104c being implemented and programs that are retained are moved to storage 104, so the available free space is separate from the buffer space.

Applicants respectfully disagree. The third paragraph of page 7 and the last paragraph of page 20 (continued to the first 3 lines of page 21) in *Browne* provides the following (emphasis added):

> [*Page 7*] Memory is cycled when the multi-source recorder player 100 is set to operate a FIFO buffer for auto recording storage allocation 104c in the storage section 104.
>
> [*pages 20-21*] The auto recording storage allocation section 305 of setup page 300 allows the user to allocate a fixed portion of storage 104 for continuous FIFO buffering, as described above. The portion of storage allocated is designated as a percentage of all storage available in storage section 104, and as shown in bar 305a. The storage allocation section 305 also preferably displays the allocation numerically at 305b.

From these recited sections, it is clear that the FIFO buffering capabilities provided through the auto recording storage allocation 104c is part of the storage section 104. That is, the auto recording storage allocation 104c is part of the storage section 104, and thus any discussion of capacity should address both sections of the storage.

Further, although *Browne* does not provide an enabling disclosure with regard to the meaning of free program memory as applied in Figure 6 of *Browne*, it is reasonable to assume that free program memory is dependent on buffer space (and unreasonable to assume otherwise), in contrast to the above-emphasized claim language. For instance, in Figure 6 of *Browne*, the screen is entitled "free program memory" and lists "4.75 hours." If a user of the system in *Browne* adjusted the initial buffer allocation to 100%, would it be reasonable to assume that the free program memory would show 0 hours of free program memory? Clearly not. On page 2 of *Browne*, the second paragraph asserts the following (emphasis added):

> It is a further object of the present invention to provide a large capacity recorder player which allows continuous recording of a program with automatic erasure, such that the material recorded first is automatically erased first when the multi-source recorder player storage reaches capacity.

That is, one cannot reasonably conclude that the recorder in *Browne* reached storage capacity (*e.g.*, 0 hours of free program memory) when the entire storage space is designated for buffer use and content is indeed actively being cached in such circumstances. On the other hand, if all the storage space with zero buffer allocation (*i.e.*, no buffer space) comprised recorded content that was permanently (*e.g.*, retained by the user or via the neural network) stored and locked, indeed storage capacity has been reached, and it is reasonable to assume that the amount of free program memory would indicate zero hours since no

content is actively be received into the storage space. In fact, *Browne* does address this latter circumstance in part where the capacity has been reached (see the bottom of page 25 of *Browne*) through an alert to the user.

Extending the analysis further, if there is 15% buffer allocation and 75% of the non-buffer space comprises retained and locked content, using the reasoning applied in the Office Action, the amount of free program memory has been exhausted, and the hours of free program memory would indicate 0 hours. As explained above, such a position is not supported in *Browne*, and is also unreasonable given that content is still being buffered and the storage capacity includes storage 104 and 104c. Although Figure 6 of *Browne* provides a listing of retained programs (*e.g.*, as designated from buffer space or through a neural network), it does not necessarily follow that the amount of free program memory is independent of buffer space, and as explained above, would appear to be an unreasonable conclusion to make.

Additionally, Applicants respectfully note that nothing in *Browne* would suggest that the buffer allocation remains constant post-initial allocation (*e.g.*, from Figure 3) in implementations where programs are retained from the buffer space (see pages 7 and 8). For instance, according to *Browne* (see page 8), as a program is retained by the user or neural network from the buffer, such as a first program in the buffer, then the next program becomes the first program. There is no discussion of re-allocating the buffer space to maintain the buffer allocation designated in Figure 3 as constant. Accordingly, one would reasonably surmise from *Browne* that the amount of free program memory would continue to be whittled away in like manner as programs are retained from the buffer, consistent with the free program memory having a dependency on the buffer. To accept the rationale of the

Office Action, one would likewise conclude that the amount of free program memory has been reduced due to the retention of a program. However, one would also have to unreasonably assume that the buffer remains constant and further improperly read into the specification mechanisms for maintaining a constant buffer space in view of the retention of programs from the buffer that are not supported by the state of the art at the time of Applicants' filing date. Accordingly, Applicants respectfully submit that *Browne* fails to anticipate at least the above emphasized claim features, and respectfully requests that the rejection to claim 1 be withdrawn.

Because independent claim 1 is allowable over *Browne*, dependent claims 2-22 are allowable as a matter of law for at least the reason that the dependent claims 2-22 contain all elements of their respective base claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 24

Claim 24 recites (with emphasis added):

> 24. A method for managing the allocation and storage of media content instance files in a hard disk of a storage device coupled to a media client device in a subscriber television system, comprising the steps of:
>
> buffering media content instances into buffer space as buffered media content instance files;
>
> tracking the size of permanent media content instance files and buffered media content instance files; and
>
> ***providing an indication of available free space, such that the indication is independent of the buffer space.***

For similar reasons provided above in association with independent claim 1, Applicants respectfully submit that *Browne* fails to disclose at least the above-emphasized

claim features. Thus, Applicants respectfully request that the rejection to independent claim 24 be withdrawn.

Because independent claim 24 is allowable over *Browne*, dependent claims 25-45 are allowable as a matter of law

Due to the shortcomings of the *Browne* reference described in the foregoing, Applicants respectfully assert that *Browne* does not anticipate Applicants' claims. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims

Claims 15 and 38 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Browne* in view of *Rakib* ("*Rakib*," U.S. Pub. No. 2002/0019984). Claims 16, 17, 39, and 40 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Browne* in view of *Radha et al.* ("*Radha*," U.S. Pat. No. 6,501,397). Claims 23 and 46 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Browne* in view of *Rakib* and further in view of *Radha*. Applicants respectfully traverses these rejections.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that

individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, Applicants respectfully submit that a *prima facie* case for obviousness has not been established.

Claims 15 and 38

Assuming *arguendo* a proper combination, Applicants respectfully submit that *Browne* fails to disclose, teach, or suggest at least the above-emphasized claim features of independent claims 1 and 24, respectively, for similar reasons to those presented above. Further, Applicants respectfully submit that *Rakib* fails to remedy these deficiencies. Since claims 15 and 38 incorporate the features of claims 1 and 24, respectively, Applicants respectfully submit that a *prima facie* case for obviousness has not been established, and respectfully request that the rejections to claims 15 and 38 be withdrawn.

In addition to the above described defects of the rejection, Applicants respectfully assert that the proposed combination is improper. It has been well established that teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q.

929, 933 (Fed. Cir. 1984). Accordingly, there must be a teaching in the relevant art which would suggest to a person having ordinary skill in that art the desirability of combining the teachings of *Browne*, which describes an audio/video recorder system that receives transmission signals (see Abstract), and *Rakib*, which describes an intelligent remote control to control services provided to a customer through headend services (see Summary, paragraph 0009). Applicants respectfully submit that such a showing has not been established, and accordingly respectfully request that the rejection be withdrawn.

Claims 16, 17, 39, and 40

Assuming *arguendo* a proper combination, Applicants respectfully submit that *Browne* fails to disclose, teach, or suggest at least the above-emphasized claim features of independent claims 1 and 24, respectively, for similar reasons to those presented above. Further, Applicants respectfully submit that *Radha* fails to remedy these deficiencies. Since claims 16, 17 and 39, 40 incorporate the features of claims 1 and 24, respectively, Applicants respectfully submit that a *prima facie* case for obviousness has not been established, and respectfully request that the rejections to claims 16, 17 and 39, 40 be withdrawn.

In addition to the above described defects of the rejection, Applicants respectfully assert that the proposed combination is improper. As explained above, there must be a teaching in the relevant art which would suggest to a person having ordinary skill in that art the desirability of combining the teachings of *Browne*, which describes an audio/video recorder system that receives transmission signals (see Abstract), and *Radha*, which describes compression techniques, or more particularly, variable coding of bit planes (see

column 1, lines 1-10). Applicants respectfully submit that such a showing has not been established, and accordingly respectfully request that the rejection be withdrawn.

Claims 23 and 46

Assuming *arguendo* a proper combination, Applicants respectfully submit that *Browne* fails to disclose, teach, or suggest at least the above-emphasized claim features of independent claims 1 and 24, respectively, for similar reasons to those presented above. Further, Applicants respectfully submit that *Radha* and *Rakib* fail to remedy these deficiencies. Since claims 23 and 46 incorporate the features of claims 1 and 24, respectively, Applicants respectfully submit that a *prima facie* case for obviousness has not been established, and respectfully request that the rejections to claims 23 and 46 be withdrawn.

In addition to the above described defects of the rejection, Applicants respectfully assert that the proposed combination is improper. As explained above, there must be a teaching in the relevant art which would suggest to a person having ordinary skill in that art the desirability of combining the teachings of *Browne*, which describes an audio/video recorder system that receives transmission signals (see Abstract), *Radha*, which describes compression techniques, or more particularly, variable coding of bit planes (see column 1, lines 1-10), and *Rakib*, which describes an intelligent remote control to control services provided to a customer through headend services (see Summary, paragraph 0009). Applicants respectfully submit that such a showing has not been established, and accordingly respectfully request that the rejection be withdrawn.

In summary, it is Applicants' position that a *prima facie* for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of

these claims is patentable over the cited art of record and that the rejection of these claims should be withdrawn.

III. Inherency

The Office Action alleges support of the features of claims 11 and 34 through the use of inherency. Applicants respectfully traverse this finding. The standard imposed in the Manual of Patent Examining Procedure (MPEP) regarding inherency, section 2163.07(a), is as follows:

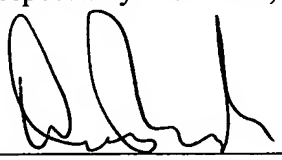
> "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

Applicants respectfully note that *Browne* shows measurements in time (see Figure 6), which is proof that measurement in units of hard disk space would not necessarily follow from the teachings of *Browne*. Thus, Applicants respectfully request that the rejection to claims 11 and 34 on grounds of inherency be withdrawn.

CONCLUSION

Applicants respectfully submits that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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